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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,226	03/23/2004	Henry Welling Lane	DIOP-07900	4994
34209	7590	02/01/2006	EXAMINER	
LAW OFFICE OF DEREK J. WESTBERG 2 NORTH SECOND STREET, SUITE 1390 SAN JOSE, CA 95113			MAI, HUY KIM	
			ART UNIT	PAPER NUMBER
			2873	

DATE MAILED: 02/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/808,226

Applicant(s)

LANE ET AL.

Examiner

Huy K. Mai

Art Unit

2873

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-39, 41-44, 46-50 and 54-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 13-22, 35-39, 41-44, 46-50 and 54-59 is/are rejected.
- 7) ☒ Claim(s) 8-12 and 23-34 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

  
Huy Mai  
Primary Examiner

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. The indicated allowability of claims 2,17,38,39,41-44,46-50,54-58, is withdrawn in view of the newly discovered reference(s) to Lindahl (6,938,277). Rejections based on the newly cited reference(s) follow.

#### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1, 15, 16 and 37 are rejected under 35 U.S.C. 102(e) as being anticipated by Hsu (6,749,299) or Lindahl (6,938,277).

Hsu discloses in Figs. 1-6, an eyeglass assembly comprising an eyeglass frame 1 having lens receptacles; and a rib 2 coupled to the eyeglass frame 1 and including a brow portion, the brow

portion having side portion 21 extending above the lens receptacles; the rib having a pliable coating (the pad) on at least some of its surface.

4. Claims 54,57,58 are rejected under 35 U.S.C. 102(e) as being anticipated by Olney (2004/0125334).

The limitations in claims 54,57,58 are shown in Olney's Figs. 5-8. Olney discloses an eyeglass assembly comprising an eyeglass frame 10 having lens receptacles; and a rib 42 a rib including a brow portion and extensions, the brow portion having side portions extending above the lens receptacles, the extensions extending downwardly along both sides of a wearer's nose, the rib 42 having a pliable coating 45 on at least some of its surface, the rib having a plurality of tabs 49,49',47,47',48,48' affixing the rib to the eyeglass frame, the plurality of tabs including at least one tab 49,49' positioned near each of left and right ends of the brow portion of the rib, and the plurality of tabs including at least one tab 48,48' positioned near each of the ends of the extensions.

Regarding claim 57, there is at least one air vent 50 positioned between a pair of tabs 47,23 (see Fig. 8).

#### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-7,17-22,59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hsu.

Absence in showing the new or unobvious results and the reasons why the use of a separate fastener such as a screw for fastening the rib to the eyeglass frame, it would have been an obvious engineering choice to use a separate fastening for fastening the rib to the eyeglass frame.

7. Claims 13,14,35,36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hsu.

It would have been obvious to a person having ordinary skill in this art to integrally mold the rib and the pliable coating (the pad) of the Hsu reference as an integral piece, since it has been held to be within the general skill of a worker in the art to make plural parts unitary as a matter of obvious engineering choice. *In re Larson*, 144 USPQ 347 (CCPA); *In re Lockart*, 90 USPQ 214 (CCPA 1951).

8. Claims 55,56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Olney.

Absence in showing the new or unobvious results and the reasons why the use of a separate fastener such as a screw for fastening the rib to the eyeglass frame, it would have been an obvious engineering choice to use a separate fastening for fastening the rib to the eyeglass frame.

9. Claims 38,39,41,42,46,48-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hsu.

The product “eyeglasses” of the method claims 38,39,41,42,46,48-50 is unpatentable over Hsu as discussed in above paragraphs# 3,6,7. It should be noted that although claims 38,39,41,42,46,48-50 “method claims”, the method steps consist of the broad steps of “forming”, “molding” and “affixing” and therefore these steps would be inherently satisfied by the apparatus of the reference.

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10. Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hsu as applied to claims 38,39,41,42,46,48-50 above, and further in view of Conway (WO 99/56942).

The claimed invention in claim 47 is shown in the Hsu reference as discussed above, except for the rib is formed in a first mold and then placed in a second mold for forming the pliable coating to the rib. Such a sequential process in the first and second molding cavities for forming a soft pliable coating to the rib having a different hardness from the soft pliable material is well known in the art as taught by Conway, for example. Therefore it would have been obvious at the time the invention was made to those having ordinary skill in the art to modify the Hsu's device by utilizing the sequential process in the first and second molding cavities for forming a pliable coating to the rib as taught by Conway. Such a modification would not change the scope of the invention in Hsu reference.

*Allowable Subject Matter*

11. Claims 8,23,30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. Claims 9-12,24-29,31-34 are objected to as being dependent upon the above objected claims.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huy Mai whose telephone number is (571) 272-2334. The examiner can normally be reached on M-F (8:00 a.m.-4:30 p.m.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky L. Mack can be reached on (571) 272-2333. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1562.



Huy Mai  
Primary Examiner  
Art Unit 2873

HKM/  
January 31, 2006